

Serial No. 09/975,101

Amendment dated December 22, 2003

Reply to Office action of October 21, 2003

### Remarks

Claims 1-20 were filed in this case. Claims 1-14, 16, 17, and 19-23 are pending in this application. Claims 20 and 23 are withdrawn from consideration. Claims 1, 8, 12-14, 16-17, 19, and 21-22 are amended. The current claim amendments are not occasioned by the prior art, rather they are made to more particularly point out and distinctly claim Applicant's invention. As the current amendments are made simply to more particularly point out and distinctly claim Applicant's invention, no further searching should be necessary.

### Rejection Under 35 U.S.C. 102

The Examiner has rejected claims 1, 2, 4, 5, 7-9, 11, 12, 14, 19 and 21 under 35 USC 102(e) as being anticipated by U.S. Pat. No. 6,345,911 to Young ("Young '911"). Applicant respectfully traverses this refusal. The Examiner has also rejected claims 1, 2, 4, 5, 7-9, 12, 14, 19, and 21 under 35 USC 102(b) as being anticipated by U.S. Pat. No. 5,839,831 to Mazzocchi ("Mazzocchi '831"). Applicant respectfully traverses these refusals.

Claim 1 has been amended to positively recite an electronic device in combination with the sleeve and applicator. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. Neither Young nor Mazzocchi teaches or suggests an electronic device in combination with the bags disclosed therein. It is respectfully submitted that claim 1 as amended is not anticipated by the cited references.

Claims 8 and 21 have been amended to more particularly point out that the applicator is removable from a flexible sleeve. Neither Young nor Mazzocchi expressly or inherently teach a removable applicator that facilitates the positioning of a flexible sleeve onto an electronic hand-held device. In particular, the alleged "applicator" in Young is a closure mechanism for the bag. The closure mechanism is formed by flat closure strips which are secured to the open end of the bag by heat sealing, welding, adhesive or the like. (Col. 3, ll. 65-Col. 4, ll. 1). Young does not teach or suggest that the closure mechanism may be removed from the bag, because this would

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compromise the integrity of the bag. Similarly, the alleged "applicator" in Mazzocchi is a series of ridges located on a reclosable bag to assist a user in opening and closing the bag. These ridges are used in conjunction with reclosable closures. Mazzocchi teaches that the ridges are secured to a pair of wall bags by methods including heat sealing or an adhesive. (Col. 5, ll. 23-25.) Nowhere does Mazzocchi teach that the applicator is removable, because in doing so, the integrity of the reclosable flexible package would be compromised. Neither the Young reference nor the Mazzocchi reference anticipates any of claims 8, 9, 12, 14, 19, and 21 because they fail to teach each and every limitation of these claims.

In light of the foregoing, it is respectfully submitted that the rejections under 35 USC 102(3) and (b) be withdrawn.

#### Rejection Under 35 U.S.C. 103

The Examiner has rejected claims 3, 6, 10, 11, 13, 16, 17 and 22 under 35 U.S.C. 103 as being obvious over Young '911 or Mazzocchi in view of U.S. Pat. No. 4,838,327 to Ambler. Applicant respectfully traverses this refusal.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

MPEP §2143; *see also, In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

The combinations of Young and Ambler or Mazzocchi and Ambler do not teach all of the limitations of the claims. All of the claims rejected under 35 USC §103 depend from independent claims 1, 8 or 21. Claim 1 recites that an electronic device is positioned within the sleeve. As explained previously, none of Young, Mazzocchi, and Ambler teach an electronic device in combination with a plastic sleeve. Moreover, claims 8 and 21 recite that the applicator is removable from the sleeve. As explained above, the applicator as taught by Young and

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Mazzocchi are flaps or ridges permanently secured to a bag to facilitate the closing and handling of reclosable bags that are used for storing items. The bag assembly in Ambler teaches a catch flap that is secured to an insert. A cuff is formed inside the bag along the bag mouth. The opening of the cuff is directed downward so that when the insert is being pulled out of the bag, the catch flap will be positioned to enter and become lodged into the interior of the cuff. This arrangement restrains any further withdrawal of the insert from out of the bag. (Col. 4, ll. 7-17). Furthermore, Ambler teaches that the "insert 14 is restrained from being completely withdrawn from out of the bag." (See e.g., Col. 3, ll. 28-32.) In light of the foregoing, the rejection under 35 USC §103 as to claims 1, 8 and 21 and any claims which depend therefrom should be withdrawn.

With respect to claims 3 and 6, these claims depend from claim 1, and should be patentable based on the arguments made with respect to claim 1. With respect to claims 10, 11, 13, 16 and 17, these claims depend from claim 8, and should be patentable based on the arguments made with respect to claim 8. Finally, with respect to claim 22, this claim depends from claim 21, and should be patentable based on the arguments made with respect to claim 21.

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In view of the above, it is respectfully submitted that claims 1 through 14, 16, 17, 19, 21, and 22 are in condition for allowance. Allowance of the claims is respectfully requested.

Respectfully submitted,

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